

Remarks:

In the last Office Action, the Examiner rejected claims 1-9. Please cancel claims 2, 4, and 9 without prejudice or disclaimer. Please amend claims 1 and 3 and add new claims 10-12. Therefore, claims 1, 3, 5-8, and 10-12 are currently pending, with claims 1, 10, and 11 being independent.

In the Office Action, the Examiner objected to claim 5 for lacking a proper antecedent basis. Claim 1 has been amended to provide for the antecedent basis.

The Examiner also rejected claim 1 under 35 U.S.C. § 102(b) as being anticipated by "Chemical Heritage." Claim 1 has been amended and should now overcome the rejection.

The Examiner further rejected claims 1, 3, and 5-8 under 35 USC § 103(a) as being unpatentable over Schireck in view of, at the least, Wahlberg. Applicant respectfully submits that all the currently pending claims are patentable over these references.

Independent claim 1 has been amended to include a unique identifier on the article and a real time video image, wherein the image is stored on a storage medium, and the image is comprised of a plurality of successive frames. As argued below, the prior art references of record do not teach or disclose a real time video image comprised of a plurality of successive frames.

New independent claim 10 claims a real time video image comprised of a plurality of successive frames and stored on a compact disc, wherein an article signed is the compact disc. The prior art references of record do not teach or disclose signing a CD and then storing a real time video image of the signing on the CD.

New independent claim 11 claims a real time video image stored on a storage medium, the image comprising a plurality of successive frames, wherein each frame includes selected subsets of

frames corresponding to the signing of the article. The prior art references of record do not teach or disclose a real time video image comprising successive frames, with each frame having a subset of frames.

Schireck discloses a sports memorabilia authentication kit, wherein a sports individual provides a fingerprint on an article, such as a baseball, and a fingerprint on a certification card. The certification card includes "indicia indicating the source and origin of the card 14," such as a logo. (Column 2, lines 61-63). The certification card is copied, and the copy is retained by the originating source. (Column 2, lines 24-25). Both the article and the certification card are part of the memorabilia kit. The purpose of providing the fingerprint of the sports individual on both the article and the certification card is for authenticating or identifying the article. Therefore, Schireck recognizes that signatures can easily be copied and proposes using the individual's fingerprint as a means for authenticating the article. (Col. 1, line 60, through Col. 2, line 4). Schireck does not propose any other means for authenticating since fingerprints are unique and not easily copied, and thus, no other method is needed or required.

As the Examiner noted, Schireck "fails to specifically teach the image being an image of the individual signing the article." (Office Action, Page 3, # 5). The Examiner argues that Wahlberg teaches a system comprising "an image (generated via camera 537) of a selected individual (a purchaser) signing an article (tape 534)"

Wahlberg discloses a business transaction apparatus for receiving payment and issuing tickets. If the payment is credit or a negotiable instrument, Wahlberg discloses an apparatus for verifying the identity of a purchaser, which includes a television camera 537 and a video screen 601. An operator of the business transaction apparatus confirms the identity of the purchaser by

comparing the purchaser's identification to an image of the purchaser on the video screen. (Column 12, lines 35-54). The image is never stored on a storage medium because there is no need to review the image at a later date. Therefore, Wahlberg does not teach a real time video image stored on a storage medium, as claimed in claim 1.

The Examiner argues that Schireck teaches a storage medium of a card 14. In Schireck, the image stored on the card is a picture, which is distinctly different from the real time video image as claimed in claim 1. Further, claim 1 now claims a real time video image comprised of a plurality of successive frames. It is impossible for the real time video image to be stored on the card. Therefore, neither Schireck nor Wahlberg teach all the limitations now claimed in claim 1 and specifically, a real time video image of the individual signing an article, wherein the image is stored on a storage medium, and the image is comprised of a plurality of successive frames.

Applicant also respectfully submits that there is no suggestion or motivation to combine Wahlberg with Schireck. As stated above, Schireck authenticates the association of an article with the individual by having the individual fingerprint the article and a certification card. A collector or holder of the article may then compare the fingerprint on the article with the fingerprint on the certification card. Schireck notes that a signature can be duplicated "with such accuracy that it is difficult to discern whether the signature is authentic." (Column 1, lines 63-54 of Schireck). Schireck further states that it is difficult to induce an individual to sign a large number of items. It is for these reasons that Schireck suggests authenticating the association of the article with the individual by comparing the fingerprint of the individual on the article to the fingerprint of the individual on the certification card. Further, Schireck clearly states that the prints "can be *visibly compared*." (Column 2, lines 11-12 of Schireck, emphasis added). Schireck also states that an

individual may not want to sign a large number of items, as noted above.

Even further, Schireck has no reason to provide a real time video image of the individual fingerprinting the article, since the fingerprint is "sufficient identifying means to certify the association of the authenticated item with the sports figure." (Column 2, lines 2-4 of Schireck). Additionally, it is clear that Schireck does not envision providing a real time video image of the individual fingerprinting the article since Schireck does not teach any system or method in which a real time video image could be used, such as providing a copy of the real time video image on a CD along with the fingerprinted article.

The Examiner proposes modifying Schireck to include a real time video image of the individual signing the article. As noted above, Schireck teaches that a purpose of the invention is to allow authentication of the association of the article with the individual without requiring the individual to sign the article. Therefore, modifying Schireck to include recording a real time video image of the individual signing the article defeats the purpose of not having to sign a large number of items.

Further, and more importantly, if Schireck is modified to include providing a real time video image of the individual signing the article, then there is no reason or purpose for Schireck's invention in the first place, i.e., fingerprinting the article for purposes of authentication. Thus, the teachings of Wahlberg drastically, if not wholly, change the principle of operation of Schireck, namely fingerprinting an article for the purpose of authenticating, since there is no need to fingerprint the article. If modified as proposed by the Examiner, Schireck has no purpose, let alone be unsatisfactory for its intended purpose of fingerprinting an article for authentication.

Even if there is a suggestion or motivation to combine from the references or the knowledge

generally available to one of ordinary skill in the art, "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). Schireck clearly does not suggest the desirability of the Examiner's proposed modification. As already noted, Schireck teaches away from the proposed modification since Schireck states that (1) the fingerprints can be visibly compared to authenticate the association of the article with individual; and (2) the individual may not want to sign a large number of items.

Applicant also respectfully asserts that Wahlberg is not, as required, properly analogous art with respect to the present invention and therefore, cannot support a finding of obviousness.

The primary test for determining whether a prior art reference is properly analogous with respect to an invention is as follows:

- (1) whether the art is from the same field of endeavor, regardless of the problem addressed; and
- (2) if the reference is not within the same field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved. *In re Clay*, 23 USPQ2d 1058, 1060 (Fed. Cir. 1992).

Furthermore, an invention cannot be considered to be within the field of endeavor of a prior art reference merely because both relate to the same industry. *Id.* at 1060. However, "[a] reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to the inventor's attention in considering his problem." *Id.* at 1061. Patent examination is necessarily conducted by hindsight, with complete knowledge and benefit of the

Applicant's invention as a guide. *In re Oetiker*, 24 USPQ2d 1443,1447 (Fed. Cir. 1992). For this reason, it is necessary to consider the "reality of the circumstances" in deciding in which fields a person of ordinary skill in the art would reasonably be expected to look for the solution to the problem facing the inventor. *Id.* at 1447. Ultimately, a rejection based on non-analogous art cannot be sustained. *Id.* at 1061.

The test set forth in *In re Clay* was also tellingly applied, for example, in *In re Oetiker*, which is cited by and discussed in MPEP §2141.01(a) in the context of determining analogousness in the mechanical arts. *In re Oetiker*, 24 USPQ2d 1443 (Fed. Cir. 1992). In *In re Oetiker*, an improvement was claimed to a stepless, earless metal clamp, with the improvement being a preassembly hook which serves to both maintain a preassembly condition of the clamp and to disengage automatically when the clamp is tightened. *Id.* at 1445. All claims were rejected over the combination of U.S. Patent No. 4,492,004 to Oetiker, which disclosed the unimproved clamp, and U.S. Patent No. 3,426,400 to Lauro, which disclosed a plastic hook and eye fastener for use in garments. *Id.* at 1445.

Oetiker argued during prosecution that Lauro's garment hook was non-analogous art in that a person of ordinary skill seeking to solve the problem facing Oetiker would not look to the garment art for the solution. *Id.* at 1445. The Examiner argued that because garments commonly use hooks for securement, a person faced with the problem of unreliable maintenance of the pre-assembly configuration of an assembly line metal hose clamp would look to the garment industry art. *Id.* 1445. On Appeal, the Board held that Lauro was analogous art because both Lauro's and the Oetiker's inventions relate to "a hooking problem." *Id.* at 1445.

The Federal Circuit, however, disagreed, stating that it had not been shown that a person of ordinary skill seeking to solve the problem facing Oetiker would reasonably be expected or

motivated to look to fasteners for garments. Furthermore:

The combination of elements from non-analogous sources, in a manner that reconstructs the Patent Owner's invention only with the benefit of hindsight, is insufficient to present a *prima facie* case of obviousness. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge cannot come from the Patent Owner's invention itself. *Id.* at 1446.

Applying the criteria of *In re Clay* and the teachings of *in re Oetiker*, Wahlberg is not in the same field of endeavor as the present invention even though both may broadly relate to identifying an individual signing an article. An inventor concerned with authenticating a signature for a memorabilia kit would not look to the surveillance and security industry as a guide. (See column 6, lines 11-13 of Wahlberg that states "[t]he camera 537 will . . . cover a maximum area for surveillance and identification purposes of the purchaser.") Just as all hooking problems are not the same in *In re Oetiker*, nor are all problems with authentication of a signature the same in the present case. Thus, Applicant strongly believes that Wahlberg does not meet the criteria set forth in *In re Clay* and is therefore not analogous art with regard to the present invention.

As a rejection based upon non-analogous art cannot and will not be sustained, Applicant respectfully asserts that the Examiner's rejections under 35 U.S.C. §103(a) relying on Wahlberg are improper and cannot be sustained.

New claims 10-12 should be in a condition for allowance given the arguments made above. The remaining claims all depend directly or indirectly from claim 1, discussed above, and thus, should also be in a condition for allowance.

In view of this response and the remarks herein, applicant respectfully submits that claims 1, 3, 5-8, and 10-12 are in allowable condition and requests a corresponding Notice of Allowance. In the event of further questions, the Examiner is urged to call the undersigned at 800-445-3460. Any additional fee which might be due in connection with this application should be applied against our Deposit Account No.19-0522.

Respectfully submitted,

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